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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,699	03/27/2001	Doug L. Rollins	MPATENT.163A	9926
20995	7590	07/20/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			NGUYEN, MINH DIEU T	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			2137	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,699	Applicant(s) ROLLINS, DOUG L.	
	Examiner Minh Dieu Nguyen	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/15/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication dated May 15, 2006 with the amendments to claims 1, 5, 8 and 9 and the cancellation of claims 2-4.
2. Claims 1 and 5-9 are pending.

Response to Arguments

3. Applicant's arguments filed May 15, 2006 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues that Simmons does not teach the transaction server checking a file attribute of the requested data to determine whether the requested data is encrypted (on page 4, Remarks), Pardikar is relied on for the teaching of this limitation (paragraph [0061]). The applicant argues Simmons does not teach the transaction server encrypting the data with the public key when the data is not encrypted and the transaction server sending the encrypted data to the player/receiver. The examiner contends that the transaction server and the content provider could function as one entity to fulfill user's request of data (paragraph [0037]), therefore the content provider could automatically encrypt the requested file using player/receiver's

key and sends the encrypted file to the player/receiver. The applicant argues Pardikar does not teach the server encrypting the data with the public encryption key when the data is not encrypted. The examiner maintains that Pardikar is relied on for the teaching of checking a file attribute of the requested data using the network server to determine whether the requested data is encrypted, moreover paragraphs 74-75 reflects another aspect of the invention, it does not mean that the server can not encrypt data. And lastly, Schneier is relied on for the teaching of public and private encryption key where the data is encrypted with public key and decrypted with private key which is also well-known in the data encryption art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons et al. (2001/0039659) in view of Pardikar et al. (2003/0046366) and further in view of Schneier (Applied cryptography).

a) As to claim 1, Simmons discloses a system and method for enabling a user to request and download selected files from provider sites (Abstract) comprising: receiving a request for data at a network server from client computer system (page 1, paragraph 0006, i.e. home user requests media file from server); automatically retrieve

using the network server a key from the client computer system, encrypting the unencrypted data with the key automatically and without user intervention and sending the encrypted data to the client computer system (page 1, paragraph 0016; page 3, paragraph 0041 and page 4, paragraph 0046).

Simmons does not explicitly disclose checking a file attribute to determine that the file is to be encrypted with the public encryption key.

Pardikar discloses a system and method for providing transparent and automatic file access comprising checking a file attribute to determine that the file is to be encrypted (page 6, paragraph 0061).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of checking a file attribute to determine that the file is to be encrypted in the system of Simmons as Pardikar teaches so as to provide security of those files that are determined to be protected.

Simmons discloses encryption keys however he does not explicitly disclose public and private encryption key where the data file is encrypted with public key.

Schneier discloses public key algorithm where often the encryption key is called the public key and the decryption key is called private key (pages 4-5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of public key algorithm in the system of Simmons and Pardikar as Schneier teaches so as to efficiently encrypt data files.

b) As to claims 5 and 8, Simmons discloses a system and method for enabling a user to request and download selected files from provider sites (Abstract)

comprising: receiving a request for a data file from a client computer system (page 1, paragraph 0006, i.e. home user requests media file from server); automatically retrieve the key from client computer system, encrypting the data file with the key automatically and without user intervention and sending the encrypted data file to the client computer system (page 1, paragraph 0016; page 3, paragraph 0041 and page 4, paragraph 0046) and storing the encrypted data file on a storage medium in the client computer system (Fig. 8, element 210).

Simmons does not explicitly disclose checking a file attribute of the requested data file.

Pardikar discloses a system and method for providing transparent and automatic file access comprising checking a file attribute of the requested data file (page 6, paragraph 0061).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of checking a file attribute to determine that the file is to be encrypted in the system of Simmons as Pardikar teaches so as to provide security of those files that are determined to be protected.

Simmons discloses encryption keys however he does not explicitly disclose public and private encryption key where the data file is encrypted with public key.

Schneier discloses public key algorithm where often the encryption key is called the public key and the decryption key is called private key (pages 4-5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of public key algorithm in the system of Simmons and Pardikar as Schneier teaches so as to efficiently encrypt data files.

6. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons et al. (2001/0039659) in view of Pardikar et al. (2003/0046366) in view of Schneier (Applied cryptography) and further in view of Prihoda et al. (6,789,195).

As to method of claim 6 and data storage medium of claim 9, Simmons, Pardikar and Schneier do not explicitly disclose an attribute (associated with the file) indicating the file is unencrypted when stored on the network server.

Prihoda discloses the data are encrypted while being transmitted between the client and server, the data then exist in unencrypted form at the central point and are generally stored in unencrypted form in a central database (col. 1, lines 22-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of attribute to indicate file is unencrypted when stored on the server as Prihoda teaches in the system of Simmons, Pardikar and Schneier so as to provide adequate protection to data.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons et al. (2001/0039659) in view of Pardikar et al. (2003/0046366) in view of Schneier (Applied cryptography) and further in view of Eldridge et al. (6,094,721).

Simmons, Pardikar and Schneier do not explicitly disclose the public and private key are based on a password.

Elridge discloses a method and apparatus for updating the password status of one of more servers in a client/server environment comprising public and corresponding private key derived from password (col. 5, lines 33-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of generating public and private key from a password as Elridge teaches in the system of Simmons, Pardikar and Schneier so as to secure password access.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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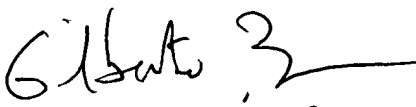
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


mdn
7/17/06


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